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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,938	06/26/2001	David Finn	70128	5330
23872	7590	12/02/2003	EXAMINER	
MCGLEW & TUTTLE, PC SCARBOROUGH STATION SCARBOROUGH, NY 10510			TREMBLAY, MARK STEPHEN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,938

Applicant(s)

FINN ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-26 and 28-32 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant: Finn et al.

Filing date: 10/28/99

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness
5 rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
10 manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35
U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
15 obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
owned at the time a later invention was made in order for the examiner to consider the applicability of 35
U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

20 Claims 17-26 and 28-32 are rejected under 35 U.S.C. § 103 as being unpatentable over
Watanabe. Watanabe teaches an identification label with a transponder unit for surface mounting
on or mounting around an object, the label having a multi layered structure comprising:

an identification layer 2 for optical marking (see figure 1);

25 a reinforcement layer 46 (see column 11) for mechanical stabilization of the identification
layer, said reinforcement layer forming a substrate with the transponder unit 51 arranged thereon;
and

an adhesion layer for mounting the identification label on the object (see column 11, lines
62-64). Watanabe also teaches that the transponder unit can include a chip and an antenna
arranged on the same area as the reinforcing layer is taught. See figure 1. Watanabe further
30 teaches different embodiments of the label, where the antenna and IC can be mounted in various
positions. See especially figures 1, 2, 9, 10, 11, 13, 18, 34a 34b 47, 49, 50, 54B, 66A-C, 67A-C,
and 72. Watanabe does not repeat the teaching of a reinforcing layer to all of these embodiments.
It would have been obvious at the time the invention was made to a person having ordinary skill in
the art to apply the teaching of a reinforcing layer to all of the embodiments taught by Watanabe
35 because a reinforcing layer can resist bending stresses, which can stress the circuit and cause it to

malfunction. Bending stresses can also degrade the usefulness of the product as a whole, as when it becomes crumpled. Thus, it would be obvious to provide the reinforcement layer in figures 1, 2, 9, 11, 13, 18, 34a 34b 47, 49, 50, 54B, 66A-C, 67A-C, and 72. The reinforcement layer is shown in figure 10 as supporting the IC at the end of the label. It can obviously support the IC
5 wherever it is on the label, and be extended over the entire length and width of the label. In such a case, the identification layer, reinforcement layer, and adhesion layer are arranged as layers each on top of one another. Even if Watanabe teaches other layers in some embodiments that could also be used in intermediate layers, removal of the different layers and their functions is not only obvious, but expressly taught by Watanabe.

10 Re claims 18-20, 26, Watanabe teaches layers comprising at least 217, where 217 clearly provides a boundary between the upper layers and the adhesive layer. The reinforcement layer for preventing stress is not shown in these figures. The adhesive layer for fixing the label to packages is not shown in other figures. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the adhesive layer, including a boundary layer
15 217 between the adhesive layer and the other layers, with the reinforcing layer, because this would provide both the ability to affix the label to packages and to resist any bending stresses that may be created in the affixing of the label to the package or any subsequent stresses. The adhesive layer is also covered with a deadening layer 218.

20 Re claim 21, a window or aperture is inherently provided in the layers for accepting the circuit, since it is embedded in the layers, and cannot occupy the same space at the same time as the layers.

Re claim 22, see figure 66a.

Re claims 24-25, the antenna in numerous embodiments is positioned on the reinforcement layer, and the adhesive covers the bottom side, forming a plane adhesion surface.

25 Re claim 29, Watanabe teaches a carrier layer 218a.

Allowable Subject Matter

Claim 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the

base claim and any intervening claims.

Response to Arguments

5 Applicant has argued that the rejection over Watanabe should be withdrawn because the embodiment shown in figures 9-11 does not have a chip and antenna unit formed on a reinforcement layer. The Examiner respectfully disagrees. Watanabe states, "[M]oreover, even when such a home-delivery slip 41 is bent, no stress is applied to the IC 51 and the battery 52 by virtue of the reinforcement 46." Clearly, one of the objects of Watanabe is to avoid bending stress
10 on the IC and battery, so it is obvious to put that reinforcement layer wherever the battery and IC are located. This includes the locations depicted in figures 1, 54B, 67A-C, and 66A-C, among others. Moreover, one skilled in the art would be aware of various strengths and types of reinforcement suitable for different purposes, as would fall within Watanabe's general teaching of a reinforcement layer. The most obvious reinforcement layer is a paperboard or cardboard
15 backing, since it is cheap, somewhat flexible, compatible with label manufacturing, and won't interfere with radio signals. Plastic could also be used for similar reasons. While Applicant is correct that Watanabe in one passage suggests that the reinforcement layer be confined to the end of the label, to allow the label to be affixed to irregular surfaces, the immediate suggestion is that the reinforcement layer could be applied across the label where it does not need to be fixed to
20 irregular surfaces. A company that ships out regularly shaped packages would have no need to confine the reinforcement layer to the end of the label. Moreover, Watanabe's suggestion in one embodiment that the IC and battery be located in one place does not preclude it's being located in other places in other embodiments. Likewise with the reinforcement layer.

25 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

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Fax Procedures

Application papers may faxed to Art Unit 2876 at (703)872-9306. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and faxed to (703) 746-5577.

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MARK TREMBLAY
PRIMARY EXAMINER

November 17, 2003